

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | | | | |
|---------------|---|-------------|---|----------------------------|---|---------------------|
| SERIAL NUMBER | 1 | FILING DATE | 9 | HOIG, FIRST NAMED INVENTOR | B | ATTORNEY DOCKET NO. |
|---------------|---|-------------|---|----------------------------|---|---------------------|

D3M1/1017

MARILYN MATTHES BROGAN
CURTIS MORRIS & SAFFORD
530 FIFTH AVENUE
NEW YORK NY 10036EXAMINER
NOLD, CART UNIT
1315

8

10/17/96

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 7-5-96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 13-28 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1-12 have been cancelled.

3. Claims _____ are allowed.

4. Claims 13-28 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit: 1315

Part III DETAILED ACTION

1. The rejections set forth in paper no. 5 are repeated as they apply to the new set of claims 13-28.

Claim Rejections - 35 USC § 112

2. Claims 14-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims that recite "small amounts of resins" are unclear because it cannot be determined how much "small amounts of resins in order to achieve elasticity properties substantially similar to one another" encompass; ie what encompass "small" is not clear and what the claim intends the value of "substantially similar to one another" is not clear. Claim 26 is unclear because there is no antecedent basis for "the viscose", "the die", "the one surface".

Applicant will please note that these identical rejections were set forth in the first office action as applied to the first set of claims 1-10, now cancelled.

3. Claims 13-28 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to including that the gap between the lips of the die, both upwards and downwards in the cylindrical disposition with the formed tube of paper and the face of the supporting metal ring or

Art Unit: 1315

cylinder is fixed at .5-.7 , this is disclosed as critical on page 12. See M.P.E.P. §§ 706.03(n) and 706.03(z).

Applicant will please note that these identical rejections were set forth in the first office action as applied to the first set of claims 1-10, now cancelled.

4. The rejection of claims 1-6 and 10 under 35 U.S.C. § 103 as being unpatentable over applicants admission of prior art is withdrawn due to applicant arguments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 13-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Underwood alone or alternatively in view of Smith. Underwood discloses a method of manufacturing porous

paper webs made from manilla hemp fibers, col. 1, lines 26-27.

The process discloses a cellulose casing having embedded therein the prebonded paper web, in the form of a tube, suitable for stuffing pieces of beef, pork and ham, col. 2, lines 6-14.

Applicants method steps are completely disclosed in col. 1, lines to col. 2, line 4. The method steps taught in the above cited section include (1) forming a paper into a tube, col. 1, lines 51-54, (2) impregnating the tube with viscose, col. 1, lines 58-62, (3) treating the tube with one or more acid or salt baths, col. 1, lines 62-70 to regenerate the cellulose. A plasticizer of glycerol is disclosed in col. 1, line 71. Underwood fails to disclose applicants claimed air dry weight of the manilla hemp fiber being no more than 15 g/m², 13 g/m² or between 12-14 g/m² or a tubing diameter of 165 mm. Applicants claimed tubing diameter of 165 mm would have been an obvious design choice for a diameter of a sausage casing to produce a tubing which would have sufficient commercial applicability and success. It would have been obvious to one having ordinary skill in the art to claim a manilla hemp fiber of from 12-15 g/m² because there is economic incentive to reduce the basis weight of the casing. Reduction of casing thickness is also desirable as it allows production of a shirred product having a higher shir density. Alternatively the secondary reference Smith, US 2,105,273 teaches the use of "extremely attenuated and porous" papers as preferable, col. 5,

Art Unit: 1315

lines 30-31. This teaching would suggest to one having ordinary skill in the art to use as light a paper as possible to provide the benefit of semi-transparency or translucency as disclosed in Smith in col. 5, lines 39-40.

Response to Amendment

7. Applicant's arguments filed 7/5/96 have been fully considered but they are not deemed to be persuasive. Applicant argues that the rejection is improper for "a number of reasons".

Applicant argues against the Examiners motivational statement (economic incentive) by stating that the "economic incentive in the context of this invention actually weight against obviousness", (p. 11, lines 2-3) and that there was a longstanding inability of those skilled in the art to achieve that goal is evidence of nonobviousness of the invention, and further cites the age of the Smith patent and Underwood, and then further argues commercial success. In response to Applicant's argument based upon the age of the references, contentions that the reference patents are old is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. *In re Neal*, 179 USPQ 56 (CCPA 1973). This is on point to applicants arguments because applicant has not shown that there was a "longstanding inability of those skilled in the art" to achieve

Art Unit: 1315

applicants goal of using light weight paper. Applicants commercial success argument is not persuasive as it is unsupported.

Applicant's claimed unexpected results showing smooth casings are not persuasive because it is the position of the Examiner that where a fibrous casing is thinner and allowed to plasticize the surface would expectedly be smoother, and thus there is really no "unexpected" results.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

CRYSTAL MALL 1 FAX CENTER

A facsimile center has been established in Crystal Mall 1, room 8D10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. the telecopier number for accessing the facsimile machine is (703) 305-5436. This new location should be used in all instances when faxing any correspondence to Examiner Charles R. Nold, Art Unit 1315. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30, November 15, 1989.

Serial Number: 08/386,813

-7-

Art Unit: 1315

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles R. Nold whose telephone number is (703) 308-4416.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

CRN
Charles R. Nold
Primary Examiner
Group 1300

crn
October 11, 1996